In re: Hind et al.
Serial No.: 09/614,982
Filed: July 12, 2000
Page 11 of 14

REMARKS

Applicants appreciate the thorough review of the present application as reflected in the Final Official Action mailed January 27, 2005. To expedite prosecution of the present application and to narrow the issues for further consideration for the Examiner and/or appeal, Applicants have cancelled Claims 22-38 without prejudice. Accordingly, Applicants submit that the rejection of Claims 22 and 27 under 35 U.S.C. § 102(b) as anticipated by United States Patent No. 5,022,077 have been obviated. Likewise, the obviousness rejections of Claims 23-26 and 28-35 under 35 U.S.C. § 103 have also been obviated. Applicants have amended Claim 2 to incorporate the recitations of Claim 3 and have amended Claim 40 to incorporate the recitations of Claim 41. Claims 3, 41 and 77 have been cancelled. Applicants request entry of the present Amendment After Final as Applicants submit that it narrows the issues for further consideration or appeal as the only remaining issue is the rejection of Claims 2, 4-21, 40 and 42-57 as obvious in light of United States Patent No. 5,844,986 to Davis (hereinafter "Davis") in view of United States Patent No. 5,293,424 to Holtey et al. (hereinafter "Holtey"). Final Action, p. 5. Applicants respectfully request the Examiner to take one final look at this rejection in light of the following remarks and to allow the present application.

The IDS

Applicants note that a Supplemental IDS was filed concurrently with Applicants previous response. The IDS appears in PAIR as filed August 6, 2004. Applicants request that an initialed copy of the PTO-1449 form be returned with any subsequent communication.

The Claims Are Not Obvious

Claims 2, 4-21, 40 and 42-57

Claims 2-21, 40-57 and 77 stand rejected as obvious in light of Davis and Holtey. Final Action, p. 5. In the interest of brevity, Applicants will not repeat the arguments made in Applicants' previous response. To assure that the present response is fully responsive to the Final Action, Applicants incorporate the arguments from Applicants' previous response by reference to the extent applicable. Applicants will address the Response to Arguments portion of the Final Action below.

In re: Hind et al.
Serial No.: 09/614,982
Filed: July 12, 2000
Page 12 of 14

Applicants have amended Claims 2 and 40 to incorporate the recitations of Claims 3 and 41. Applicants submit that Claims 2 and 40 are patentable over the cited references for the reasons discussed in Applicants' previous response with reference to Claims 2 and 40 and are further patentable for the reasons discussed with reference to Claims 3 and 41.

Turning to the specifics of the Response to Arguments section of the Final Action, Paragraph 3 of the Response to Arguments section of the Final Action responds to Applicants' argument that neither Davis nor Holley describe using the state of an access latch to control access to a programmable memory, stating that Davis and Holtey use RAM latches to protect programmable memory. Final Action, p. 2. However, Applicants have not argued that Davis and Holtey do not use latches but have argued that controlling a BIOS update based on authentication is not controlling access to the programmable memory based on the state of an access latch as recited in Claim 2. In particular, Applicants argued that, while the cited portions of Davis describe the selective application of a BIOS update based on authentication of the BIOS update, there is no indication in the cited portions that access to a programmable memory is based on the state of a latch. In Davis, the application of the update may be controlled by the results of the authentication process but that does not necessarily mean that access to the memory is controlled by the results of the authentication process, as recited in Claim 2.

Paragraph 4 of the Response to Arguments section of the Final Action asserts that Figure 3, element 160 of Davis discloses controlling access to a programmable memory. Final Action, pp. 2-3. As discussed in Applicants' previous response, whether or not a BIOS update is performed is not controlling access to a programmable memory, it is deciding whether to perform a BIOS update. There is no indication that the memory is not accessible for write operations, only that the particular data will not be written to the memory, not because write operations cannot be performed to the memory, but because the data is invalid. As such, Applicants submit that the cited portions of Davis do not disclose controlling access to the memory as recited in Claim 2 but, instead, describe selective writing of data based on the validity of the data.

Paragraph 5 of the Response to Arguments section of the Final Action responds to Applicants' arguments that a proper motivation to combine has not been established by reciting the law and stating that "[i]n this case, knowledge generally available to one of

In re: Hind et al.
Serial No.: 09/614,982
Filed: July 12, 2000
Page 13 of 14

ordinary skill in the art" provides the motivation to combine. Final Action, p. 3. Applicants submit that this unspecified knowledge is exactly the type of unsupported motivation to combine references that was rejected by the Federal Circuit in *In re Sang Su Lee*, stating:

> This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Merely stating that the Examiner understands the law of obviousness does not provide a proper basis for establishing an obviousness rejection and, in fact, reinforces the argument that the basis is an unsupported conclusory assertion.

Paragraph 6 of the Response to Arguments section of the Final Action responds to Applicants arguments regarding Claims 3 and 41 (now incorporated into Claims 2 and 40) that recite "allowing access to a **memory where the update control program resides** when the access latch allows access to the programmable memory" and "preventing access to the **memory where the update control program resides** when the access latch prevents access to the programmable memory." Final Action, p. 3. The Examiner asserts that col. 2, line 61 and Figure 2, element 60 of Davis describe these recitations of amended Claims 2 and 40. Final Action, p. 3. In particular, the Examiner asserts that the cryptographic coprocessor that validates and controls access to the BIOS memory and that retrieves instructions from the BIOS somehow teaches the recitations of Claims 3 and 41. Final Action, p. 3. However, the cited portions of Davis do not describe allowing and preventing access to memory where the update control program resides. In fact, Figure 2 of Davis describes the steps associated with a "boot up" phase. Davis, col. 3, lines 30-31. Furthermore, in rejecting Claim 2 it appears that the Examiner is interpreting a latch that reflects the authentication of the new BIOS in Davis as controlling access to the memory. However, in amended Claim 2, the same latch that controls access to the programmable memory also controls access to the memory where the update control program resides. Applicants submit that there is no suggestion in Davis

In re: Hind et al.
Serial No.: 09/614,982
Filed: July 12, 2000
Page 14 of 14

that the determination of whether the BIOS update is authentic allows or prevents access to the memory of the cryptographic processor where an update program resides.
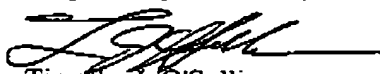
Paragraph 7 of the Response to Arguments section of the Final Action responds to Applicants arguments that Davis does not disclose or suggest "obtaining application rules information from an extension of at least one certificate associated with the update" and "evaluating the rules information obtained from the at least one certificate" as recited in Claims 20 and 56. Final Action, p. 3. However, the response never explains how a rule is provided in a certificate extension. There is no indication in the cited portions of Davis that a rule is included in a certificate extension. Thus, Applicants submit that Claims 20 and 56 are separately patentable over the cited references.

Finally, Applicants note that Applicants requested that the Official Action provide support for the unsupported assertions as to the prior art contained in the previous Official Action. In particular, Applicants requested that, if the rejections were maintained, the Official Action support each assertion with a citation to a prior art reference. There does not appear to be any further support provided in the Final Action. Accordingly, Applicants request withdrawal of the rejections based on such unsupported assertions as to the prior art.

Conclusion

Main claims have been cancelled to narrow the issues for consideration. In light of the above discussion, Applicants submit that the remaining claims are in condition for allowance, which action is respectfully requested.

Respectfully submitted,

Timothy J. O'Sullivan
Registration No. 35,632

Customer No. 20792
Myers Bigel Sibley & Sajovec
P. O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401